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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,696	11/01/2001	Michihiro Ota	84042	1278

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WELSH & KATZ, LTD.  
22nd Floor  
120 South Riverside Plaza  
Chicago, IL 60606-3913

EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/044,696

Applicant(s)

OTA ET AL.

Examiner

John L Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

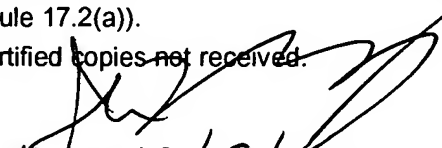
**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
JOHN LEONARD YOUNG  
12/9/2004  
PRIMARY EXAMINER  
Paper No(s) / Mail Date

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)

Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **NON-FINAL REJECTION**

**(Paper#12/09/2004)**

### **DRAWINGS**

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **CLAIM OBJECTIONS**

2. Claim 12 and claim 15 are objected for minor typographical errors.

Claim 12, at line 5, delete the term “fro” and replace it with the word --from--.

Claim 15, at line 4, delete the word “sole” and replace it with the word --sold--.

### **CLAIM REJECTIONS — 35 U.S.C. §101**

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful  
process, machine, manufacture, or composition of matter or  
any new and useful improvement thereof, may obtain a

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patent therefore, subject to the conditions and requirements  
of this title.

3. Claims 12-17 is rejected under 35 U.S.C. 101, because said claims are directed to non-statutory subject matter.

As per claims 12-17 & 19-22, as drafted said claims are not limited by language within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b), even though said claims are limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75 , 47 USPQ 2d at 1602 (Fed Cir. 1998) ; *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999).

Note: it is well settled in the law that "[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims." (See MPEP 2173.05( q )).

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**CLAIM REJECTION — 35 U.S.C. §103( a )**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Davis US 6,105,008; class 705/41, (Aug. 15, 2000) [US f/d: June 11, 2000] (herein referred to as ("Davis")).

As per claim 1, Davis (col. 2, ll. 1-15) discloses: "*Service payment terminal . . . can be . . . a vending machine. . . .*"

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Davis (col. 1, ll. 55-65) discloses: Card reader interface . . . includes the *software and hardware necessary for communication with the outside world. . . . [with] a close-coupled interface, a remote-coupled interface, or a variety of other interfaces.*

Davis (col. 8, ll. 10-30) discloses: client terminal . . . is any suitable *device for interacting with a stored-valued card . . . and for communicating over a network to a payment server or a merchant server. . . . client terminal . . . may be embodied in any portable device such as . . . a cellular telephone, or any variety of a personal digital assistant (PDA). . . .*

Davis (col. 22, ll. 30-50) discloses: Points . . . that a consumer *accumulates to achieve benefits may be linked to a particular consumer by an account number, password, or other identifier. The amount of points accumulated for each consumer may be stored on web server 208' . . . or . . . in a loyalty application on the consumer's card."*

Davis (col. 23, ll. 28-50) discloses: *"the benefit is arranged to be delivered to the user."*

Davis (the ABSTRACT) discloses: *"A consumer uses his smart card at the client terminal in order to purchase goods and/or services from the remote merchant server. . . ."* therefore,

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Davis (FIG. 11A; col. 1, ll. 55-65; col. 2, ll. 1-15; col. 8, ll. 10-30; col. 22, ll. 30-50; col. 23, ll. 28-50; and whole document) implicitly shows: “A promotion method comprising the steps of: issuing, from a point issuing unit to a user, point information related to predetermined points when a commodity is sold by an automatic vending machine; adding system information about a distributor of the commodity to the point information issued fro[sic] the point issuing unit in the point information issuing step; sending the point information with the system information added in the system information adding step to a center unit together with identification information of the user by operations of a portable terminal carried by the user; receiving, at the center unit, the point information and the identification information of the user sent in the point information sending step; separately managing, by the center unit, services to be provided to the user according to the system information added to the point information received in the receiving step in association with the distributor of the commodity and providing a predetermined service to the user by referring to the services managed in the managing step. . . .”

Davis lacks an explicit recital of: “point information related to predetermined points when a commodity is sold by an automatic vending machine; adding system information about a distributor of the commodity to the point information issued fro[sic] the point issuing unit in the point information issuing

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step. . . .” even though Davis (FIG. 11A; col. 1, ll. 55-65; col. 2, ll. 1-15; col. 8, ll. 10-30; col. 22, ll. 30-50; and col. 23, ll. 28-50) implicitly shows same.

It would have been obvious to one of ordinary skill in the art at the time of the invention that the above cited disclosure of Davis (FIG. 11A; col. 1, ll. 55-65; col. 2, ll. 1-15; col. 8, ll. 10-30; col. 22, ll. 30-50; col. 23, ll. 28-50; and whole document) implicitly shows “point information related to predetermined points when a commodity is sold by an automatic vending machine; adding system information about a distributor of the commodity to the point information issued fro[sic] the point issuing unit in the point information issuing step. . . .” and it would have been obvious to modify and interpret the disclosure of Davis cited above as implicitly showing “point information related to predetermined points when a commodity is sold by an automatic vending machine; adding system information about a distributor of the commodity to the point information issued fro[sic] the point issuing unit in the point information issuing step. . . .”, because modification and interpretation of the cited disclosure of Davis would have provided means “*to access any of a variety of Web servers in order to load . . . award points. . . .*” (see Davis (col. 5, ll. 40-54), based on the motivation to modify Davis so as to “*receive the benefits of the program, much in the same way that currency is loaded.*” (See Davis (col. 5, ll. 54-56).



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As per claim 13, Davis shows the method of claim 12.

Davis (FIG. 10; col. 1, ll. 55-65; col. 2, ll. 1-15; col. 8, ll. 10-30; col. 22, ll. 30-50; col. 23, ll. 28-50; and whole document) implicitly shows: “wherein the system information adding step comprises the step of adding the system information to the point information by the point issuing unit.”

Davis lacks an explicit recital of: “adding the system information to the point information by the point issuing unit.”

It would have been obvious to one of ordinary skill in the art at the time of the invention that the above cited disclosure of Davis (FIG. 10; col. 1, ll. 55-65; col. 2, ll. 1-15; col. 8, ll. 10-30; col. 22, ll. 30-50; col. 23, ll. 28-50; and whole document) implicitly shows “adding the system information to the point information by the point issuing unit. . . .” and it would have been obvious to modify and interpret the disclosure of Davis cited above as implicitly showing “adding the system information to the point information by the point issuing unit. . . .”, because modification and interpretation of the cited disclosure of Davis would have provided means “*to access any of a variety of Web servers in order to load . . . award points. . . .*” (see Davis (col. 5, ll. 40-54), based on the motivation to modify Davis so as to “*receive the benefits of the program, much in the same way that currency is loaded.*” (See Davis (col. 5, ll. 54-56).

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As per claim 14, Davis shows the method of claim 12.

Davis (FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11A; col. 1, ll. 55-65; col. 2, ll. 1-15; col. 8, ll. 10-30; col. 22, ll. 30-50; col. 23, ll. 28-50; and whole document) implicitly shows: “the point information is sent to the center unit through a system terminal disposed at the distributor of the commodity, and the system information adding step comprises the step of adding the system information to the point information by the system terminal.”

Davis lacks an explicit recital of: “the system information adding step comprises the step of adding the system information to the point information by the system terminal.”

It would have been obvious to one of ordinary skill in the art at the time of the invention that the above cited disclosure of Davis (FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11A; col. 1, ll. 55-65; col. 2, ll. 1-15; col. 8, ll. 10-30; col. 22, ll. 30-50; col. 23, ll. 28-50; and whole document) implicitly shows “the system information adding step comprises the step of adding the system information to the point information by the system terminal. . . .” and it would have been obvious to modify and interpret the disclosure of Davis cited above as implicitly showing “the system information adding step comprises the step of adding the system information to the point information by the system terminal. . . .”, because modification and interpretation of the cited disclosure of

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Davis would have provided means *“to access any of a variety of Web servers in order to load . . . award points. . . .”* (see Davis (col. 5, ll. 40-54), based on the motivation to modify Davis so as to *“receive the benefits of the program, much in the same way that currency is loaded.”* (See Davis (col. 5, ll. 54-56).

As per claim 15, Davis shows the method of claim 12.

Davis (FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11A; col. 1, ll. 55-65; col. 2, ll. 1-15; col. 8, ll. 10-30; col. 22, ll. 30-50; col. 23, ll. 28-50; and whole document) implicitly shows: “the point information system includes at least one of a commodity code unique to the commodity, date information when the commodity is sold, price information of the commodity and an area code related to a place where a machine having sole[sic] the commodity is installed; and the center unit collectively changes the services to be provided to the user according to at least one of a kind commodity, a date when the commodity is sold, a price of the commodity and a place where the machine having sold the commodity is installed.”

Davis lacks an explicit recital of: “the point information system includes at least one of a commodity code unique to the commodity, date information when the commodity is sold, price information of the commodity and an area code related to a place where a machine having sole[sic] the commodity is installed; and

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the center unit collectively changes the services to be provided to the user according to at least one of a kind commodity, a date when the commodity is sold, a price of the commodity and a place where the machine having sold the commodity is installed. . . .” even though Davis (FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11A; col. 1, ll. 55-65; col. 2, ll. 1-15; col. 8, ll. 10-30; col. 22, ll. 30-50; col. 23, ll. 28-50; and whole document) implicitly shows same.

Official Notice is taken that both the concepts and the advantages of “the point information system includes at least one of a commodity code unique to the commodity, date information when the commodity is sold, price information of the commodity and an area code related to a place where a machine having sole[sic] the commodity is installed; and the center unit collectively changes the services to be provided to the user according to at least one of a kind commodity, a date when the commodity is sold, a price of the commodity and a place where the machine having sold the commodity is installed. . . .” were notoriously well known and expected in the art at the time of the invention because and it would have been obvious to modify and interpret the disclosure of Davis cited above as implicitly showing “the point information system includes at least one of a commodity code unique to the commodity, date information when the commodity is sold, price information of the commodity and an area code related to a place

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where a machine having sole[sic] the commodity is installed; and the center unit collectively changes the services to be provided to the user according to at least one of a kind commodity, a date when the commodity is sold, a price of the commodity and a place where the machine having sold the commodity is installed. . . .”, because modification and interpretation of the cited disclosure of Davis would have provided means “*to access any of a variety of Web servers in order to load . . . award points. . . .*” (see Davis (col. 5, ll. 40-54), based on the motivation to modify Davis so as to “*receive the benefits of the program, much in the same way that currency is loaded.*” (See Davis (col. 5, ll. 54-56).

As per claims 16-18, Davis shows the method of claim 15.

Davis (FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11A; col. 1, ll. 55-65; col. 2, ll. 1-15; col. 8, ll. 10-30; col. 22, ll. 30-50; col. 23, ll. 28-50; and whole document) implicitly shows all the elements and limitations of claims 16-18; however,

Davis lacks an explicit recital of some of the elements and limitations of claims 16-18, even though Davis (FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11A; col. 1, ll. 55-65; col. 2, ll. 1-15; col. 8, ll. 10-30; col. 22, ll. 30-50; col. 23, ll. 28-50; and whole document) implicitly shows same.

Official Notice is taken that both the concepts and the advantages of all

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the elements and limitations of claims 16-18 were notoriously well known and expected in the art at the time of the invention because and it would have been obvious to modify and interpret the disclosure of Davis cited above as implicitly showing all the elements and limitations of claims 16-18, because modification and interpretation of the cited disclosure of Davis would have provided means “*to access any of a variety of Web servers in order to load . . . award points. . .*” (see Davis (col. 5, ll. 40-54), based on the motivation to modify Davis so as to “*receive the benefits of the program, much in the same way that currency is loaded.*” (See Davis (col. 5, ll. 54-56).

Independent claim 19 is rejected for substantially the same reasons as independent claim 12.

Dependent claim 20 is rejected for substantially the same reasons as independent claim 15.

Independent claim 21 is rejected for substantially the same reasons as independent claim 12.

Dependent claim 22 is rejected for substantially the same reasons as

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independent claim 15.

### **RESPONSE TO ARGUMENTS**

5. Applicant's arguments (Amendment paper filed 09/ 07/2004) concerning the rejections in the prior Office Action have been considered but are not persuasive for the following reasons: Applicant's arguments are moot based on new grounds of rejection herein presented by the Examiner.

### **CONCLUSION**

6. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

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Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

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(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

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Hand delivered responses may be brought to:

Seventh floor Receptionist  
Crystal Park V  
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young

Primary Patent Examiner

December 9, 2004